

Appln. No. 09/933,332  
Amdt. dated July 7, 2006  
Reply to Office Action of April 7, 2006  
Docket No. BOC9-2001-0007 (242)

### **REMARKS/ARGUMENTS**

These remarks are made in response to the Office Action of April 7, 2006 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due.

Claims 1, 4-15, 17, 18, 20-22, 24, 26, 27, 36, 39-47, 52, 55-57, 59-64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,564,251 to Gudjonsson, *et al.* (Gudjonsson) and over U.S. Publication Patent Application No. 2002/0023132 A1 to Tornabene *et al.* (Tornabene).

In response, Applicants have amended Independent Claims 1, 16, 23, 24, 28, 38, 51, 58 and 59 to include a feature not disclosed or taught by the cited prior art references. Claims 2, 3, 37, 38 have been previously cancelled. The claims amendments are fully supported throughout the Specification. No new matter has been introduced by virtue of the claim amendments.

With respect to independent Claims 1 and 36 as amended, Gudjonsson fails to expressly or inherently teach a method for selecting and sharing contact list information between participants of a chat session according to a method of Applicants' invention. Gudjonsson fails to expressly or inherently teach the step of selecting a first and second contact list, comparing the selected first and second contact list, identifying common and non-common contacts between the first the second selected contact list, and displaying common contacts in a first visual list and non-common contacts in a second visual list. Moreover, Gudjonsson fails to expressly or inherently teach that, if the first party's contact list is modifiable, the second party can modify the first party's contact list by adding contact information to the contact list.

With regard to amended Independent Claims 1 and 36, the steps of selecting and comparing a first contact list with a second contact list, and identifying common and non-common contacts between the selected lists are supported in the specification (See, e.g., Specification, p. 19, line 10-22.). The step of comparing is also a subject of Claim 9 which was rejected on Page 5 of the Office Action. Accordingly, the subject matter of Claim 9 is immediately addressed as it is substantive to overcoming the 103(a) rejection on Independent Claims 1 and 36.

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On Page 5, the Examiner notes a section of Gudjonsson addressing aspects of contact sharing (Col. 29 to Col. 30, and Col 26. lines 40-59). Gudjonsson however does not teach selecting one or more contact lists, comparing contacts in the contact lists, and identifying common or non-common contacts between the lists. Notably, Gudjonsson addresses shared contacts within the context of a connected network for purposes of scalability. Whereas Gudjonsson is directed to assessing the loading caused by shared contacts that are connected, Applicants' invention is directed to sharing information between one or more active users. The term "shared contacts" is used by Gudjonsson in the context of determining a number of active connections having an associated system load for supporting shared connections. Applicants utilize the term "shared contacts" in the context of sharing contact information between users, not connectivity.

In particular, Gudjonsson discloses a mathematical loading model based on a number of users having shared contacts. The loading model evaluates connections between shared contacts for determining resource services (e.g. system bandwidth) that are allocated to each contact. Gudjonsson is concerned with estimating resources that are used during a connection between shared contacts for assessing an overall load on the system. Gudjonsson is interested in determining the effects of system loading based on a number of connections that are shared by active users; that is, "shared contacts". The shared contacts are active connections. With regard to Gudjonsson, aspects of contact sharing are directed to evaluating a loading for distributing the loading in accordance with a number of active users having shared connections. In Gudjonsson, the "shared contacts" are users that are connected and utilizing system resources for communicating amongst one another. Understandably, Gudjonsson is directed to user scalability. As one skilled in the art can appreciate, the terminology for shared contacts as presented by Gudjonsson is presented in light of assessing loading conditions. That is, the loading is evaluated based on active connections that are currently being shared. This, however has nothing to do with selecting and comparing contact information between one or more users. Applicants' invention is not concerned with loading or the effects of sharing resources over an active connection. In fact, Applicants' invention is not concerned with sharing connectively loading at all, which is the exclusive focus of Gudjonsson's system. Applicants' invention is clearly

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concerned with sharing contact information between users. The contact information may be one of an address or a name for identifying a contact. Moreover, in Applicants' invention, it is a user that selects one or more contact lists for evaluating common or non-common contacts.

Applicants respectfully assert, therefore, that Gudjonsson fails to expressly or inherently teach every feature recited in Independent Claims 1 and 36 as amended. Thus, Applicants respectfully maintain that the claims thus define over the prior art. Applicants further respectfully assert that whereas each of Claims 2-15 and 37-50 depends from one of amended independent Claims 1 and 36, while reciting additional features, these dependent claims likewise define over the prior art. Again, Gudjonsson has nothing to do with contact lists, let alone the modification of one user's contact list by another user.

With respect to independent Claims 16, 23, 28, 51 and 58, as amended, Gudjonsson fails to expressly or inherently teach a method for selecting and sharing contact list information by comparing the respective contact lists of different parties, identifying similar contacts among the lists, and presenting similar contacts in a pre-selected visual format and dissimilar contacts in a different visual format. Again, in the portion cited at page 5 of the Office Action, Gudjonsson describes the mathematical model for determining network scalability. (Col. 28, line 65 - Col. 30, line 60; see also Table 4 of Col. 29.) In describing the mathematical model, Gudjonsson observes that "usually connected users share some contacts. That is, some two connected users x and y will be interested in following the online status of the same contact z - therefore, users x and y share the contact z."

This portion of Gudjonsson, however, fails to expressly or inherently teach every feature recited in amended independent Claims 16, 23, 28, 51 and 58. Firstly, the mathematical model described by Gudjonsson has nothing to do with selecting, comparing, identifying, or presenting common contacts; Gudjonsson merely makes the observation that some commonality is likely and that a determination of shared contacts can be made. Merely recognizing that there may be common contacts between two parties, however, teaches nothing, expressly or inherently, about how to select and compare contact lists and, by so doing, identifying common contacts in the respective contact lists. Moreover, as previously mentioned Gudjonsson is concerned with active connections that are shared

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between contacts. The shared contacts are shared network connections which is not comparable to shared contact information. Notably, Gudjonsson uses the designation CS for "Connection Servers" within the mathematical equation, which is not the same as shared contacts (Col. 17, line 9). Gudjonsson further fails to expressly or inherently teach selecting shared contact lists and presenting common contacts between the shared contact lists. Moreover, Gudjonsson nowhere teaches anything about presenting similar contacts in a pre-selected visual format and dissimilar contacts in a different visual format based on an identification and comparison of different contact lists. With regard to Claim 23, it further follows that Gudjonsson fails to teach, either expressly or inherently, one party's modifying another's contact list by adding third-party contact information to the contact list.

Accordingly, Applicants respectfully assert that Gudjonsson fails to expressly or inherently teach every feature recited in independent Claims 16, 23, 28, 51 and 58, as amended, and that the claims thus define over the prior art. Applicants further respectfully assert that whereas each of Claims 2-22 and 51-57 depends from one of amended independent Claims 16 or 51, while reciting additional features, these dependent claims likewise define over the prior art.

With respect to independent Claims 24 and 59, Gudjonsson fails to expressly or inherently teach providing contact management in a chat session according to any of the methods taught by Applicants' invention. For example, Gudjonsson fails to teach, expressly or inherently, the sending of a token of recommendation originated by one chat session participant to another – wherein the token of recommendation provides an introduction for the other chat session participant – and transferring the token of recommendation to yet a third chat session participant. Similarly, Gudjonsson fails to expressly or inherently teach that, if the third chat session participant accepts the token of introduction, a third contact list with contact information for the second chat session participant can be modified.

On page 5 of the Office Action, the Examiner points out that Gudjonsson teaches permitting a user associated with a contact list to reject a modification. However, Gudjonsson does not teach presenting a recommendation prior to modifying a contact list. The recommendation is not a request to modify a contact list. The recommendation is a statement concerning character or qualifications of a user, which can be reviewed by other

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users. For example, a first user may generate a recommendation for a second user. As an example, the first user can draft a text message containing the second user's credentials along with a brief summary of the first user's professional relationship with the second user. The recommendation can be provided to the other users who are familiar with the first user but unfamiliar with the second user for introducing the second user to the other users. Understandably, the token of recommendation is a form of recommending one user to one or more other users.

Gudjonsson does not teach any form or aspect of recommendation. Gudjonsson describes a network service that facilitates a user's knowing an online status of others, setting an online status and storing contacts in a hierarchical list. (Col. 26, lines 30-50; see also Col. 29, line 64 – Col. 30, line 30.) None of these portions, however, pertain to the sending of a token of recommendation as taught by Applicants' invention. The only portion of Gudjonsson that seems remotely related to the claims concerns a network service's receiving a contact list request from a user whose user data has not been previously loaded to a user server. (Col. 26, lines 48-50.) Gudjonsson merely states that in such circumstances, a user server loads the user data from the service database. This teaches nothing, however, about one party's sending a token of recommendation— a type of electronic letter of introduction – that introduces another party to a third party that knows the originator of the token but the not the party being introduced. (See Specification, p. 24, lines 2-4.)

Applicants respectfully submit, therefore, that Gudjonsson fails to expressly or inherently teach every feature recited in independent Claims 24 and 59, and that the claims thus define over the prior art. Applicants also respectfully submit that since dependent Claims 24-27 and 59-64 depend from one of these independent claims while reciting additional features these dependent claims likewise define over the prior art.

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### CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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